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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,545	04/16/2004	Peter Tartaglia	MAROT 3.0-037 DIV	2167
530	7590	06/20/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ELDRED, JOHN W	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/826,545

Applicant(s)

TARTAGLIA ET AL.

Examiner

J. Woodrow Eldred

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04162004, 07262004</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

### DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "determining a condition" is vague and indefinite since it is not clear what is having a condition determined. Is it referring to the valve itself, or some other element? In claim 1, line 4, "by a profile" is vague and indefinite since it is not clear what makes up the profile, or to what is being profiled. In claim 1, line 5, "adjusting the valve during the operation of the valve" is vague and indefinite, since it is not clear if "adjusting" and "operation" are the same operation or a different one, and if they are different, how do they differ? In claim 4, "the profile determines" is unclear because it appears that a profile is only a data set and could not perform the claimed step that it "determines" something, but would only provide parameters for another element to "determine" an action. In claim 4, line 3, "a predetermined cycle" is vague and indefinite, since it is not clear what is being cycled. In claim 15, "for sensing a sensed condition" is vague and indefinite, since it is not clear what elements conditions are being sensed. In claim 15, "a predetermined cycle" is vague and indefinite since it is not clear what is being cycled. In claim 15, "a predetermined profile" is vague and indefinite since it is not clear what is being profiled. In claim 15, line 9, "arranged with" is vague and indefinite since it is not clear if the driver is functionally connected with the controller or just positionally "arranged" with the controller.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4-9, 15, and 17-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Winter (5,042,750).

See especially column 3, lines 28-37 and 49-58; and column 4, lines 54-68, which show a desired profile and sensing and determination of the speed and weight of an aircraft.

5. Claims 1, 3, 4, 7, 9-11, 15-18, 21, and 22 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ferguson (6,293,838).

See especially column 3, line 2-4 and 47-68; and column 4, lines 17-23 and 32-40. Note that the disclosed control of engine speed will inherently involve control (and reduction) of speed of the disclosed marine craft. Note also that a plurality of profiles are used, including engine speed, transmission switching speeds, type of engine, and type of use, and that the data for type of engine inherently defines a "type of craft".

6. Claims 1, 2, 7, 8, 15, and 16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Anderson (6,81,850).

See especially column 6, lines 28-38 and column 7, lines 22-44.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3644

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-14 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter in view of either one of Tamai (6,123,093) or Gautier et al (6,206,329).

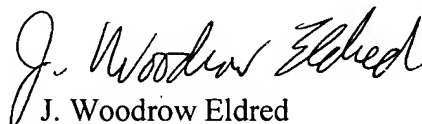
Winter discloses a method of controlling the operation of a valve comprising determining a condition, comparing the condition to a profile of desired conditions, and automatically operating the valve based on the sensed and desired conditions. Winter fails to teach testing operation of the valves and providing back-up valves or actuators if there is a fault. Both Tamai and Gautier et al teach that it is well known to test valve systems and provide a back-up system in case of failure. See especially column 9, lines 12-38 of Gautier et al and column 3, lines 33-45 and 46-66 of Tamai. Motivation to combine is the increased performance of being able to operate even upon failure of the primary valve or actuator. To employ the teachings of either Tamai or Gautier et al on the system of Winter and have testing of the valve system and providing a back-up valve system in case of failure is considered to have been obvious to one having ordinary skill in the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Woodrow Eldred whose telephone number is 571-273-6901. The examiner can normally be reached on Monday to Thursday, from 8:00 a.m. to 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "J. Woodrow Eldred".

J. Woodrow Eldred  
Primary Examiner  
Art Unit 3644

JWE